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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,721	12/13/2000	Louis Brown Abrams	D. N. 7218	4531

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT PAPER NUMBER

1771

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/735,721	ABRAMS, LOUIS BROWN	
	Examiner	Art Unit	
	Cheryl Juska	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 16-38, 40-45, and 48-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 16-18, 25-31, 38, 40-45 and 48-54 is/are rejected.
- 7) ☒ Claim(s) 19-24 and 32-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/05; 11/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed January 5, 2006, has been entered. Claims 3-15, 39, 46, and 47 have been cancel, while claims 1, 18, 26, and 27 have been amended as requested. new claims 50-54 have been added. Thus, the pending claims are 1, 2, 16-38, 40-45, and 48-54.
2. Applicant's arguments with respect to the new matter rejection under 35 USC 112, 1st paragraph of claim 41 is hereby withdrawn due to applicant's arguments (Amendment, paragraph spanning pages 10-11).

Specification

3. The objection to the specification set forth in section 4 of the last Office Action is hereby maintained. Applicant's traversal thereof has been considered in full, but is found persuasive only in part. Specifically, the examiner concedes that the drawing provides support for "fringe material." [Note the withdrawal of the objection to the drawings below.] However, the drawing does not provide support for the amendment, which states said fringe material "can be applied to the peripheral edges of the flocked release sheet 1 or substrate 15 during this manufacture process." While the drawing does support fringe material on two edges of the flocked release sheet, the drawing does not support fringe on all peripheral edges or on the substrate 15. Therefore, the new matter objection is maintained.

Drawings

4. The objection to Figure 3 set forth in section 5 of the last Office Action is hereby withdrawn as discussed above.

Claim Objections

5. Claims 25 and 38 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Said claims are not further limiting because independent claims 1 and 26 have been amended to limit the hot melt sheet to being pre-formed.
6. Claim 41 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. Said claim is not further limiting because independent claim 26 has been amended to limit at least most of the flock to being in direct physical contact with the thermoplastic hot melt sheet.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 43 and 45 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, as set forth in sections 6 and 7 of the last Office Action. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As discussed above, the specification as originally filed does not provide adequate support for the fringe material on more than two edges or from the edges of the substrate.

9. New claims 51 and 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the specification does not provide support for the limitation “wherein *substantially none* of the thermoplastic hot melt sheet fails to contact the free ends of the flock.” In other words, this negative recitation limits the hot melt sheet to being continuous with the flock. However, the scope of the claims enable said flock to being present in a discontinuous “pattern.” In this instance, according to new claims 51 and 52, the hot melt sheet must also be discontinuous, which contradicts the present claim limitation that said sheet is continuous.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claims 44 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claims 44 and 45 recites the limitation “the substrate.” There is insufficient antecedent basis for this limitation in the claim since “the substrate” has been deleted from claim 1 from which claims 44 and 45 depend.

Claim Rejections - 35 USC § 103

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 1, 2, 16-18, 25-31, 38, 40-42, 44, 48, and 49 stand rejected under 35 USC 103(a) as being unpatentable over US 4,687,527 issued to Higashiguchi in view of US 4,810,549 issued to Abrams et al. as set forth in section 10 of the last Office Action.

15. Claims 43 and 45 stand rejected under 35 USC 103(a) as being unpatentable over the cited Higashiguchi and Abrams references and in further view of “*When is a mouse pad really a rug?*” by R. Landwehr as set forth in section 11 of the last Office Action.

16. New claims 50, 53, and 54 are rejected under 35 USC 103(a) as being unpatentable over US 4,687,527 issued to Higashiguchi in view of US 4,810,549 issued to Abrams et al.

The limitations of new claims 50, 53, and 54 are analogous to those presented in other claims (e.g., claims 1 and 26). As such, said claims are rejected for reasons analogous to those presented in the rejections of said other claims and for the reasons set forth below in the *Response to Arguments*.

Allowable Subject Matter

17. Claims 19-24 and 32-37 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. While the prior art teaches the flock transfers of claims 1 and 26, said prior art does not teach or fairly suggest that the thermoplastic hot melt sheet comprises two parts that differ in properties. Therefore, claims 19-24 and 32-37 contain allowable subject matter.

Response to Arguments

18. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

19. Applicant traverses the above rejection by arguing that the process of the present invention is significantly different than the prior art process and that the present process has several advantages over said prior art processes (Amendment, pages 11-14). In response, it is noted that the present invention is drawn to a product rather than a process of making said product or even a product-by-process. As such, the method of making the product is not material to the rejection of the product as presently claimed. Additionally, the differences in the processes and the advantages of the present process asserted by applicant are not features of the instant claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, the new limitation that the thermoplastic hot melt sheet is pre-formed, solid, and self-supporting is descriptive of the method of making the product

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and not necessarily given patentable weight at this time. [Note paragraph spanning pages 5-6 of the last Office Action.]

20. Applicant also traverses the rejection by arguing the references individually (Amendment, pages 15-17). In response, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In other words, applicant has failed to persuasively argue the combination of references. It is believed that upon modifying the Higashiguchi reference with the teachings of Abrams, one would produce the presently claimed invention. For example, while neither reference alone teaches the new features of the amended claims (i.e., continuous and uniformly thick thermoplastic hot melt sheet and perpendicular flock contacting said sheet), it is believed said features will be produced by the combination of references. Therefore, applicant's arguments are found unpersuasive and the above rejections stand.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHERYL A. JUSKA
PRIMARY EXAMINER

cj
March 8, 2006